

REMARKS

Claims 1, 3-7 and 9-22 are pending in this application. By this Amendment, claims 16, 18, 20 and 22 are amended. No new matter is added by these amendments.

Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

Applicants appreciate the courtesies shown to Applicants' representatives by Examiner Ke in the June 22, 2006 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

The Office Action, on page 2, rejects claims 1, 3-7, 9-14, 18 and 22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,661,437 to Miller et al. (hereinafter "Miller") in view of U.S. Patent No. 5,845,124 to Berman, further in view of U.S. Patent No. 5,781,247 to Wehmeyer et al. (hereinafter "Wehmeyer") and further in view of U.S. Patent No. 6,115,720 to Bleizeffer et al. (hereinafter "Bleizeffer"). The Office Action, on page 9, rejects claims 15 and 19 under 35 U.S.C. §103(a) as being unpatentable over Miller in view of Berman, further in view of Wehmeyer, and further in view of Bleizeffer, further in view of U.S. Patent No. 5,751,953 to Shiels et al. (hereinafter "Shiels"). Additionally, the Office Action, on page 10, rejects claims 16, 17, 20 and 21 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,067,084 to Fado et al. (hereinafter "Fado") in view of Miller, further in view of Wehmeyer, and further in view of Bleizeffer. The Applicants respectfully traverse these rejections.

Miller discloses a processing device, including an on-screen user interface display, which incorporates a means for generating a display of the plurality of hierarchical ordered menus (Abstract). The Office Action concedes that Miller does not teach displaying items which have been already set along with their set parameters, items which are being set along with parameters to choose from, and items which have been assigned and not yet been set

displayed in the single frame of the display device so as to be distinguishable from one another.

Additionally, Miller does not teach displaying all of the plural items in a single frame of the display device when one of the plural setting frames is displayed. Rather, as shown in Figs. 5, 7 and 8, Miller teaches an automatic scrolling operation for maintaining user viewability of the currently selectable menu items. For example, in Fig. 5, the user has progressed through the menu structure from menu level 1 to the currently active menu level 4 via highlighted items 530, 510, 505, 540, 545 and 555. The controller automatically scrolls the displayed portion of the menu structure horizontally to position the dialog box at the right of the display screen. Thus, previously selected menus have been scrolled from right to left and off the screen leaving displayed screen image 500 (col. 6, line 65 - col. 7, line 17). For at least this disclosure, and contrary to the assertion in the Office Action, Miller cannot reasonably be considered to teach displaying all of the plural items in a single frame of the display when one of the plural setting frames is displayed.

The Office Action relies on Berman to overcome the deficiencies of Miller. This reliance is misplaced. Berman discloses systems and methods for generating and displaying a symbolic representation of a network model (Abstract). Berman provides a method of generating and displaying a symbolic representation of a network model on a display device of a computer system.

Berman does not overcome the deficiencies of Miller as discussed above. Berman teaches that only fields previously defined and the region currently being defined are distinguished by contrasting colors and/or visual indicators, i.e., solid bold lines, dotted bold lines, etc., and does not teach items which have been already set along with their set parameters, items which are being set along with parameters to choose from, and items which have been assigned and not yet been set are displayed in the single frame of the display device

so as to be distinguishable from one another, as is positively recited in the independent claims.

The Applicants respectfully submit that Berman is not available as a prior art reference because it constitutes non-analogous art. "In order to rely on a reference as a basis of rejection of an Applicant's invention, the reference must either be in the field of Applicants' endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Berman, that deals specifically with network modeling, with the method of Miller, that deals specifically with generating a display of the plurality of hierachial ordered menus, in order to provide a distinction that is easily recognized by the user. Berman specifically states that the particular problem with which the inventor was concerned was addressing a need in the art for a network modeling tool that recognizes symmetries and common groupings of network elements and a proposed network, and uses the same to provide a simplified representation of the network (col. 1, lines 56-60). Further, Berman goes on to teach that the particular problem being addressed was a further need in the art for a network modeling tool that easily modifies, or reconfigures, a network model without substantially redefining the entire representation of the network. The subject matter of the pending claims provides an operating method and device, which can enhance the operability when plural items are sequentially set, and an image processing apparatus using the operating method and device. Therefore, one of ordinary skill in the art would not have been motivated to incorporate the method of Berman with the method of Miller.

Therefore, Berman cannot reasonably be considered to overcome the deficiencies of Miller with respect to subject matter positively recited in, for example, independent claim 1.

The Office Action relies on Wehmeyer to overcome deficiencies of Miller and Berman in this regard.

Wehmeyer discloses a television receiver, which provides a hierarchy of menus for controlling functions affecting the display of the video image (Abstract). Specifically, the Office Action asserts that Wehmeyer teaches displaying both the set menu items and the menu items that have not been set in a single frame. However, Wehmeyer does not teach items which have been assigned and not yet been set, when all of the button fields have been assigned, are displayed in a single frame of the display device so as to be distinguishable from one another. Rather, Wehmeyer simply teaches displaying items which have been assigned, as shown in Fig. 2, elements 203, 204 and 205. Elements 206 and 207 represent menu items that have not been assigned, and element 209 represents one of a plurality of options for being assigned to elements 206 and 207. Therefore, Wehmeyer does not teach displaying items, which have been assigned and not yet been set. For example, referring to Fig. 6 of the disclosure, elements 1364 and 1365 represent menu items, which have been assigned and not yet been set.

Therefore, Wehmeyer cannot reasonably be considered to overcome the deficiencies of Miller and Berman, with respect to the combinations of features, positively recited in the independent claims.

The Office Action relies on Bleizeffer to overcome the deficiencies of Wehmeyer. However, Bleizeffer, in the manner as applied in the Office Action, does not overcome the deficiencies discussed above with respect to Miller, Berman or Wehmeyer. Additionally, the applied references of Shiels and Fado, alone or in some combination, do not overcome the deficiencies of Miller, Berman or Wehmeyer as discussed above.

In addition to the arguments discussed above, the Office Action fails to make a *prima facie* case of obviousness for at least the following additional reasons. The United States Court of Appeals for the Federal Circuit stated, "in making the assessment of differences between the prior art and the claimed subject matter, section 103 specifically requires consideration of the claimed invention "as a whole." *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004). Inventions typically are new combinations of existing principles or features. *Env'tl. Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements"). The "as a whole" instruction in Title 35 prevents evaluation of the invention part by part. *Ruiz*, 357 F.3d at 1275. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. *Id.* This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result - often the essence of invention. *Id.*" *Princeton Biochemicals, Inc., v. Beckman Coulter, Inc.*, 75 USPQ2D 1051, 1054 (Fed. Cir. 2005).

The Federal Circuit went on to state, "[c]ontrary to this reasoning, section 103 requires assessment of the invention as a whole. *Id.* This "as a whole" assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. *Id.* In other words, section 103 requires some suggestion or motivation, before the invention itself, to make the new combination. See *In re Rouffet*, 149 F.3d 1350,

1355-56 (Fed. Cir. 1998)." *Princeton Biochemicals, Inc., v. Beckman Coulter, Inc.*, 75

USPQ2D 1051, 1054 (Fed. Cir. 2005).

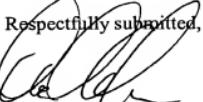
As discussed with the Examiner during the personal interview, Applicants respectfully submit that the Examiner has divided the subject matter of the pending claims into their individual components, and then simply found a reference that arguably corresponds to each component. Repeating the language of the Federal Circuit, "[t]his line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components." *Id.* Therefore, based on the above-quoted standard set forth by the Federal Circuit, the Office Action fails to support a *prima facie* case of obviousness.

For at least these reasons, Applicants respectfully submit that any permissible combination of Miller, Berman, Wehmeyer, Bleizeffer, Shiels and Fado cannot reasonably be considered to teach, or to have suggested, the combinations of all of the features recited in at least independent claims 1, 7, 13, 14, 16, 18, 20 and 22. Further, claims 3-6, 9-12, 15, 17, 19 and 21 are also neither taught, nor would they have been suggested, by any permissible combination of the applied prior art references for at least the respective dependence of these claims directly or indirectly on the independent claims as enumerated above, as well as for the separately patentable subject matter that each of these claims recites.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3-7 and 9-22 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,


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